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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,989	03/26/2004	David Hughes Horne	00179.0002	9603

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EXAMINER

ALANKO, ANITA KAREN

ART UNIT PAPER NUMBER

1765

DATE MAILED: 12/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/809,989

Applicant(s)

DAVID HORNE

Examiner

Anita K. Alanko

Art Unit

1765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-6 is/are rejected.*
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the specification lacks explicit basis that, as in claim 4, line 5, the CPC can penetrate to “all” apexes of cracks.

The specification also lacks basis for “dipping for discrete times” as in claim 5, line 3. Page 8, [0019] describes rolling, spraying or brushing, but not dipping. Nor does the specification cite to perform the etch “discrete times.”

The specification lacks explicit basis for “increases the apex radii” as in claim 5, line 7. Page 7, paragraph [0016] describes rounding out the crack tips, but not explicitly increasing the radii.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 5-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 5, the phrase “dipping for discrete times” is new matter. Claim 6 fails to cure the deficiencies of claim 5, and is therefore also rejected.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Clerici et al (EP 976795 A2).

As to claim 4, Clerici discloses a method comprising cleaning ([0020] – “hot alkaline cleaner” on steel bolts), rinsing ([0020]-line 3) and drying ([0020]-last line). Since the method of Clerici is the same as the instant invention, it is expected to enable the penetration of corrosion preventive compound to apexes of cracks, scratches and gouges. Note that claim 4 does not cite that the corrosion preventive compound is applied.

As to claim 5, Clerici discloses to etch ([0020] – pickling by 10% HCl) discrete times, rinsing and drying. Note that the claims have open “comprising” language and are not limited to a certain order of the steps. Since the method steps are the same as the instant invention, the method is expected to minimize stress intensity factors compared to unetched apex radii locations.

As to claim 6, Clerici discloses surface treatment with a corrosion preventive compound ([0021]-[0023] – the “antifriction coating” which also provides corrosion resistance), rinsing ([0020]- line 18) and drying ([0020] – line 19). Since the method of Clerici is the same as that cited, it is expected to have the same results of minimizing stress intensity factors and distributing forces and potential energy compared to the unetched metal.

Response to Amendment

The objection to the specification and 35 USC 112 rejections are withdrawn in view of the amendments to the specification and the claim amendments clarifying the relative terms are between the unetched and etched materials.

The specification lacks explicit basis for the new claim terminology, as described above. "Dipping discrete times" is new matter.

The claims remain rejected over Clerici. The 102 rejection over Lawrence is withdrawn since claim 3 has been cancelled.

The three affidavits filed on May 26, 2006, although containing persuasive arguments, are insufficient to overcome the rejection of claims based upon Clerici as set forth in the last Office action because: the arguments are not commensurate in scope with the claim language. See the "Response to Argument" below.

Response to Arguments

Applicant's arguments filed 9/22/06 have been fully considered but they are not persuasive. The arguments are copied and pasted from the three affidavits filed on May 26, 2006. These arguments are not commensurate in scope with the claim language. Applicant argues that Clerici does not have etching, and argues that pickling removes surface oxides and other contaminants, but does not remove metal. In response, pickling is etching, and since the surface is modified, it is etched.

Applicant argues that Clerici has a different purpose for HCl. In response, Clerici need not have the same purpose as in the instant invention.

Applicant argues that the Clerici process includes sacrificial anodes, whereas the Horne technology uses a liquid CPC that has a maximum surface tension of 30 dynes/cm. In response, the claims do not cite surface tension.

Applicant argues that cathodic protection materials fail to do the functions required by the Horne technology. In response, the claims are relative to unetched material, and therefore although the results may not be the same as in the Horne technology, they are commensurate in scope with the claim language.

Applicant argues that no logic as been found to suggest that the Clerici patent processes would anticipate the instant claimed invention. In response, claim 4 simply cites cleaning, rinsing and drying. The claim 4 language of “so said corrosion preventive compound can penetrate to all apexes” is intended use and is given little weight. The claim does not cite applying a corrosion preventive compound. What is different about the cleaning and rinsing of Clerici compared to the instant invention?

Applicant argues that the Horne art provides a totally new purpose for an etch. In response, Clerici discloses etching pretreatment for a CPC coating.

The arguments about Lawrence are persuasive. There is no motivation to combine the teachings of Clerici and Lawrence because of the different types of CPCs.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anita K. Alanko whose telephone number is 571-272-1458. The examiner can normally be reached on Mon-Fri until 2:30 pm (Wed until 11:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nadine Norton can be reached on 571-272-1465. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Anita K. Alanko

Anita K Alanko
Primary Examiner
Art Unit 1765